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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,205	02/27/2004	Hilmar Wechsel	08020.0013-00	4680

22852 7590 03/24/2009

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ART UNIT	PAPER NUMBER
3689	

MAIL DATE	DELIVERY MODE
03/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/787,205	WECHSEL, HILMAR	
	Examiner	Art Unit	
	THUY VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on December 15, 2008, wherein:

Claims 1-47 are currently pending;

Claims 13, 21, 24, 31, 32, 40, 41 have been amended;

Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-8, 9-12, 13-19, 20** (Method) are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 1-20**,** the method claims are:

(1) not tied to a particular machine or apparatus, nor

(2) transforms a particular article to a different state or thing.

With respect to **1-8, 9-12, 13-19, 20,** the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. For

instance in claim 1, the process steps of "*receiving, determining, issuing, creating, updating, authorizing, creating, assigning, associating, exchanging"* is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

Here claims **1-8, 9-12, 13-19, 20** fail to meet the above requirements since there is not a sufficient tie to another statutory class (2) transformation, and thus is directed to nonstatutory subject matter. Insertion of the use of another statutory class (computer) such as "computer-implemented" or "using a computer" features in the preamble and the critical functions/bodies of the claims would overcome the rejections.

Claim 32 is rejected under 35 U.S.C. 101 because the claims deal with system containing 3 items: 2 information repository/databases and do not meet any of the statutory items such as process (method), machine (apparatus), manufacture (product) or composition. The system claims appear to be an apparatus claim in a preamble "*a system for managing…*", however, there are no structures or functional elements which are required in an apparatus claim. For instant, the independent 32 recited "*a first database; a second database*" are appear to be software. Therefore, the claims are directed to nonstatutory subject matter.

Response to Arguments

4. Applicant's arguments on 12/15/08 with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

As for the arguments on the 101 rejection, Applicant stated that the features recited in the independent claims 1, 9, 13 and 20 "*are tie to statutory class in that each*

relates to a method of recites one or more steps that is tied to a product, a management system, and /or a database. Such physical apparatuses are clearly statutory and tied to the claimed methods. Second, independent claims 1, 9, 13, and 20 include step of "creating" a record in a management system or database. The recited "creating" steps inherently transform the underlying subject matter (e.g., a management system or a database) such that records are brought into existence in the respective physical apparatus". The Examiner respectfully disagrees for the following reasons: the cited elements "a management system" and/or "a database" are not apparatus per se. Without proper elemental structure citations, "system" or "database" are or could be considered as software components and not "apparatus" as argued. The statement that "independent claims 1, 9, 13 and 20 are tied to another statutory class such as a product, a management system, and/or database" is not correct for the reason set forth above. Applicant's comment that the step of *"creating" a record in a management system or database* inherently meets the "transform" test is not persuasive because this is considered as insignificant extra-solution activity and will not transform an unpatentable principle into a patentable process. Applicant's comment that the transformation test is normally present in chemical, electrical, and mechanical cases, etc., is not persuasive for the cited reasons above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over HAUSER ET AL (US 6,536,659).

As for independent claim 1, HAUSER ET AL discloses a method for managing a return of a product, the method comprising:

receiving a return request for the product;

{see at least figures 1, 4-6, col. 3, lines 45-48, col. 8, lines 10-22 discloses the merchant (14) or merchant web site 212 receive a request from customer for returning merchandise}

determining whether the return request is authorized;

{see at least figures. 1, 4-6, col. 3, lines 56-63, col. 4, lines 1-15, col. 8, lines 23-44, and lines 59-67, col. 9, lines 1-3, discloses the merchant (14) or return authorization engine 216 of merchant determine *the authorization for the return of the merchandise*};

Issuing (providing/sending), from a first system, a return authorization information including authorization number (RAN) or bar code for the return request when the return request is determined to be authorized;

{see at least figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 disclose a authorization bar code/RAN is *provided*/issued *to customer from a merchant 202/*a first management system; and col. 8, lines 30-60 merchant (14) or return authorization engine (213) as a first system that *send or provide* or *distribute the authorization bar code/or RAN to the customer*}

creating a record in a second management system for the return request, the record comprising the RAN; and

{see at least figures 1- 2, col. 2, lines 27-31 disclose information/data about the product return include the return label is entered into the central database of Central return facility to indicate that the merchandise as been received; col.6, lines 18-49 discloses National Return Center or Central return facility 100 as a second management system wherein the record or information/data e.g. a return authorization label including an authorization bar code/RAN is stored in the database on computer 56}

updating the record (entering new data about the return product) in the second management system after the product has been returned/received.

{see figure 2, col. 2, lines 27-31; col. 5, lines 5-19 disclose information/data about the product return is entered into the central database of Central return facility to indicate that the merchandise has been received; and if the return product that was received match the expected merchandise, an electronic transmission/message is sent to merchant 14 indicating a complete return of the merchandise occurred}

Note, as for the term “management” in the “first management system” and “second management system”, this is inherently included in the "merchant customer product return system" and “central return facility network system” {see Figs. 1-2}. Alternatively, the insertion of the term “management” in the system above would have been obvious to indicate “monitoring” effects if desired. Also, as indicated above, as the limitation of”updating a record” in the last step, this is inherently included in the features “*product return is entered into the central database to indicate that the merchandise has been received*, and *send the message to the merchant indicating a complete return of the merchandise occurred* {see figure 2, col. 2, lines 27-31; col. 5, lines 5-19}. Alternatively, in view of the teaching of the term “updating a record”, it would have been obvious to use the features “providing or sending the return authorization code” and sending the message back to the merchant indicated a complete return of the merchandise occurred so that the merchant can be able to keep track the status of which merchandised has been returned at the facility or warehouse.

As for dep. claim 2, which deals with the first management system is a customer relationship management system (CRM), this is taught in HAUSER ET AL, see at least figures 1, 4-6B disclose a merchant (14), merchant (202), or merchant website (212), and merchant call center 214 where the customer can directly contact.

As for dep. claim 3, which deals with the second management system comprises a ware house management (WM) system, this is taught in HAUSER ET AL, figures 2-3 "return central facility”.

As for dep. claim 4, which deals with the information/data/or record about the delivery request, this is taught in HAUSER ET AL, col. 2, lines 27-38. Note: "the record/information or data of a delivery request" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for dep. clam 5, which deals with the communicating information between the two parties, e.g. first and second management system utilizing the RAN, this is taught in HAUSER ET AL, col. 2, line 5-23, 21-57,figure 1-2.

As for dep. claim 6, which deals with providing a shipping label in response to approving the return request, the shipping label comprising the RAN, this is taught in HAUSER ET AL, figures 1-2, col. 4, lines 15-22.

As for dep. claim 7, which deals with the quantity of the product for a return product, this is fairly taught in HAUSER ET AL, see figures 1-3.

As for dep. claim 8, which deals with splitting the record in the second system into a plurality of new records with the RAN, this is fairly taught in col. 4, lines 2-35, figure 1.

As for independent claim 9, HAUSER ET AL disclose

authorizing a request from a customer to return a product;

{see at least figures. 1, 4-6, col. 3, lines 56-63, col. 4, lines 1-15, col. 8, lines 23-44, and lines 59-67, col. 9, lines 1-3, discloses the merchant (14) or return authorization engine 216 of merchant determine *the authorization for the return of the merchandise*};

creating at least one record in each of a plurality of management systems when the request for the product return is authorized;

{see figure at least figures 1-2, 5 and 6B, col. 4, lines 2-22, col. 5, lines 5-15, col. 6, lines 36-49; disclose the merchant and rental return facility have the record/information about the product return, e.g. the merchant system identify the customer information includes a description of the merchandise when the product is authorized for returning and then transmit this information/record to the rental facility center, when the return product is received at the rental facility, the product contain a return authorization label is scanned and then are stored in the database of the rental facility ; and figure 6B disclose the Return Authorization data 218 is transmitted from the return authorization engine (216) of merchant system to the national return center}

assigning a unique identifier to the product return;

{see figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 disclose a authorization bar code/RAN is *provided*/sent *to customer* for returning product }

associating the unique identifier with each record corresponding the product to be returned/received;

{see figures 1-2, 5-6B, col. 4, lines 16-56, col. 5, lines 5-20, col. 6, lines 18-49 disclose the transmitting the authorization bar code/unique identifier about the return product from the merchant system to the return facility system, the facility issues the

return label including the bar code/unique identifier to customer, when the merchandise/product is returned at the facility, the bar code will be scanned to identify the merchant and merchandise being returned}

Exchanging/transmitting information regarding the product return between the plurality of management systems utilizing the unique identifier;

{see at least figures1, 5-6B, col. 2, lines 9-25, lines 49-59; col. 5, lines 5-19 col. 8, lines 29-54 disclose the transmitting of the RA data (218) about the product return from the merchant system (return authorization engine) to the national return center system. This indicates that the unique identifier is stored in both systems (merchant and central return facility). The facility issues the return label including the bar code/unique identifier to customer, when the merchandise/product is returned at the facility, the bar code will be scanned to identify the merchant and merchandise being returned. If the return product that was received/returned match the expected merchandise, an electronic transmission/message is sent to merchant 14 indicating a complete return of the merchandise occurred}.

Note: as for the limitation"*associating the unique identifier with each record*" in the fourth step, this is inherently included as indicated above. Alternatively, in view of the teaching of the term "*associating the unique identifier*", it would have been obvious to use the features "transmitting the authorization bar code/unique identifier about the return product from the merchant system to the return facility system, when the merchandise/product is returned at the facility, the bar code will be scanned to identify the merchant and merchandise being returned" so that the merchant can be able to

keep track the status of which merchandised has been returned at the facility or warehouse.

As for claim 10, which deals with the plurality of management systems comprises at least one of a customer relationship management (CRM) system, a warehouse management (WM) system, this is fairly taught in HAUSER ET AL, see figures 1-2 (merchant system and central return facility system)

As for claim 11, which deals with the plurality of management systems comprises the warehouse management (WM) system, this is fairly taught in HAUSER ET AL, see figures 1-2 (central return facility)

As for claim 12, which deals with plurality of management systems comprises a logistics, execution and shipping (LES) management system; this is fairly taught in HAUSER ET AL {see figures 1-3}

As for independent claim 13, HAUSER ET AL discloses a method for managing a product return, the method comprising:

assigning at least one return authorization number (RAN) to the product return;

{see figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 disclose a authorization bar code/RAN is *provided*/sent *to customer* for returning product }

creating, a return authorization record for the product return, the return authorization record comprising the RAN

{see at least figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 col. 8, lines 30-60 merchant website or return authorization engine (213) system provide the Return authorization data *include the authorization bar code/or RAN to the customer*}

creating, in a second database, a warehouse record for the product return, ware house record comprising the RAN

{see at least figures 1- 2, col. 2, lines 27-31 disclose information/data about the product return include the return label is entered into the central database of Central return facility to indicate that the merchandise as been received; col.6, lines 18-49 discloses National Return Center or Central return facility 100 as a second management system wherein the record or information/data e.g. a return authorization label including an authorization bar code/RAN is stored in the database on computer 56}

updating the return authorization and the warehouse record to include information associated with the RAN

{see figure 2, col. 2, lines 27-31; col. 5, lines 5-19 disclose information/data about the product return is entered into the central database of Central return facility to indicate that the merchandise has been received; and if the return product that was received match the expected merchandise, an electronic transmission/message is sent to merchant 14 indicating a complete return of the merchandise occurred}

Note: As for the limitation of "updating a record" in the last step, this is inherently included in the features "*product return is entered into the central database to indicate that the merchandise has been received*, and *send the message to the merchant indicating a complete return of the merchandise occurred* { see figure 2, col. 2, lines 27-31; col. 5, lines 5-19}. Alternatively, in view of the teaching of the term "updating a record", it would have been obvious to use the features "providing or sending the return

authorization code" and sending the message back to the merchant indicated a complete return of the merchandise occurred so that the merchant can be able to keep track the status of which merchandised has been returned at the facility or warehouse.

Note as indicated above, the first database in the second step is inherently included in the figure 5-6B "merchant website and return authorization engine" network system. Alternatively, the insertion of the term "a first database" in the merchant system above would have been obvious to provide the database or server in the merchant site in order to create and store the data/information/record about the product return e.g. the return authorization code so that the merchant can be able to keep track the status of which merchandised has been returned.

As for claim 14, which deals with the return authorization record comprises a plurality of return authorization items, this is fairly taught in HAUSER ET AL {see figures 1-3}.

As for claim 15, which deals with the return authorization item comprises a unique RAN, this is fairly taught in HAUSER ET AL {see figures 1-3}.

As for claim 16, which deals with the warehouse record comprises a plurality of pending delivery items, each of the pending delivery items being created for at least one of the return authorization items, this is fairly taught in HAUSER ET AL {see figure 2-3}

As for claim 17, HAUSER ET AL discloses wherein the second database is a warehouse management (WM) system {see figure 1-2}.

As for claim 18, which deals with information regarding to the return authorization record, e.g. product type and a quantity, this is fairly taught in HAUSER

ET AL , see figures 1-3. Furthermore: "the record/information or data of the return authorization" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claim 19, which deals with creating a shipping label based on the return authorization record and communicating the shipping label to a customer, this is fairly taught in HAUSER ET AL, {see figures 1-2, col. 4, lines 16-23}

As for claim 20, HAUSER ET AL discloses a method for managing a product return, the method comprising:

Indexing/creating a record in a first database for a product return using at least one unique identifier

{see at least figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 col. 8, lines 30-60 merchant website or return authorization engine (213) provide the Return authorization data *include the authorization bar code/or RAN to the customer*}

creating a record for the product return in a second database, the record in the second database comprising the unique identifier;

{see at least figures 1- 2, col. 2, lines 27-31 disclose information/data about the product return include the return label is entered into the central database of Central

return facility to indicate that the merchandise as been received; col.6, lines 18-49 discloses National Return Center or Central return facility 100 as a second management system wherein the record or information/data e.g. a return authorization label including an authorization bar code/RAN is stored in the database on computer 56}; and

exchanging, between the first and second databases, information related to the product return, wherein each item of exchanged information is identified by the unique identifier

{see at least figures1, 5-6B, col. 2, lines 9-25, lines 49-59; col. 5, lines 5-19 col. 8, lines 29-54 disclose the transmitting of the RA data (218) about the product return from the merchant system (return authorization engine) to the national return center system. This indicates that the unique identifier is stored in both systems (merchant and central return facility). The facility issues the return label including the bar code/unique identifier to customer, when the merchandise/product is returned at the facility, the bar code will be scanned to identify the merchant and merchandise being returned. If the return product that was received/returned match the expected merchandise, an electronic transmission/message is sent to merchant 14 indicating a complete return of the merchandise occurred}.

Note as indicated above, the first database in the second step is inherently included in the figure 5-6B “merchant website and return authorization engine” network system. Alternatively, the insertion of the term “a first database” in the merchant system above would have been obvious to provide the database or server in the merchant site

in order to create and store the data/information/record about the product return e.g. the return authorization code so that the merchant can be able to keep track the status of which merchandised has been returned.

As for independent claim 21, HAUSER ET AL disclose a computer readable medium including a memory containing instructions for carrying out a method for managing a product return, the method comprising:

creating a record in a customer relationship management (CRM) system for a product return using at least one return authorization number

{see at least figures 4-6B, col. 7, lines 63-67, col. 8, lines 1-10 col. 8, lines 30-60 merchant website or return authorization engine (213) provide the Return authorization data *include the authorization bar code/or RAN to the customer*}

creating a record for the product return in a warehouse management (WM) system using the return authorization number

{see at least figures 1- 2, col. 2, lines 27-31 disclose information/data about the product return include the return label is entered into the central database of Central return facility to indicate that the merchandise as been received; col.6, lines 18-49 discloses National Return Center or Central return facility 100 as a second management system wherein the record or information/data e.g. a return authorization label including an authorization bar code/RAN is stored in the database on computer 56}; and

exchanging between the management systems information related to the product return, wherein each item of exchanged information is identified by the return authorization number

{see at least figures1, 5-6B, col. 2, lines 9-25, lines 49-59; col. 5, lines 5-19 col. 8, lines 29-54 disclose the transmitting of the RA data (218) about the product return from the merchant system (return authorization engine) to the national return center system. This indicates that the unique identifier is stored in both systems (merchant and central return facility). The facility issues the return label including the bar code/unique identifier to customer, when the merchandise/product is returned at the facility, the bar code will be scanned to identify the merchant and merchandise being returned. If the return product that was received/returned match the expected merchandise, an electronic transmission/message is sent to merchant 14 indicating a complete return of the merchandise occurred}.

Note, as for the term “management” in the “first management system” and “second management system”, this is inherently included in the "merchant customer product return system" and “central return facility network system” {see Figs. 1-2}. Alternatively, the insertion of the term “management” in the system above would have been obvious to indicate “monitoring” effects if desired.

As for claim 22, which deals the record in the CRM system is a return authorization record, this is fairly taught in HAUSER ET AL see figure 5-6B

As for claim 23, which deals with the record in the WM system is a pending delivery record, see figure 2-3.

Note as for dep. claim 22-23 “the record/information or data " have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for independent claim 24 which is about a computer readable medium containing instructions for carrying a method of managing a return of a product. This claim has the same limitation as independent claim 13 above. Therefore it is rejected as the same independent claim 13 sets forth above.

As for claims 25-26, which deals with the return authorization record comprises a plurality of return authorization items and a return authorization number, this is fairly taught in HAUSER ET AL {see figure 1-3}.

As for claim 27, which deals with delivery item is created for each return authorization item , this is fairly taught in HAUSER ET AL {see figure 1-3}.

As for claim 28, which deals with the second database is a warehouse management database, this is fairly taught in HAUSER ET AL {see figure 1-3}

As for claim 29, which deals with the return authorization record further comprises a product type and a quantity, this is fairly taught in HAUSER ET AL {see figure 1-3}.

Note: As for dep. claims 25-29, "the record/information or data of a the return authorization" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claim 30, which deals with creating a shipping label based on the return authorization record and communicating the shipping label to a customer, this is fairly taught in HAUSER ET AL {see figure 1-3}

As for independent claim 31 which is about a computer readable medium including a memory containing instructions for carrying a method of managing a return of a product. This claim has the same limitation as independent claim 9 above. Therefore it is rejected as the same independent claim 9 sets forth above.

As for independent claim 32, HAUSER ET AL discloses a system for managing a return of a product, the method comprising:

a first database configured to receive a return request for the product, and to generate a first record comprising a return authorization number (RAN) for the product if the return request is authorized

{see figure 5-6B; col. 8, lines 10-45, merchant website and return authorization engine for generating the authorization number/authorization bar code

a second database, in communication with the first database, configured to create a second record corresponding to the return, the second record comprising the RAN

{see figures 1-2, figure 5-6B, col. 4, lines 2-23, disclose the merchant system communication with the return facility database, e.g transmitting the return authorization data to the return facility; and

wherein the first and second database are each configured to exchange information regarding the return utilizing the RAN

{see at least figures1, 5-6B, col. 2, lines 9-25, lines 49-59; col. 5, lines 5-19 col. 8, lines 29-54 disclose the transmitting of the RA data (218) about the product return from the merchant system (return authorization engine) to the national return center system. This indicates that the unique identifier is stored in both systems (merchant and central return facility). The facility issues the return label including the bar code/unique identifier to customer, when the merchandise/product is returned at the facility, the bar code will be scanned to identify the merchant and merchandise being returned. If the return product that was received/returned match the expected merchandise, an electronic transmission/message is sent to merchant 14 indicating a complete return of the merchandise occurred}.

Note as indicated above, the first database in the second step is inherently included in the figure 5-6B “merchant website and return authorization engine”. Alternatively, the insertion of the term “a first database” in the merchant system above would have been obvious to provide the database or server in the merchant site in order

to create and store the data/information/record about the product return e.g. the return authorization code so that the merchant can be able to keep track the status of which merchandised has been returned.

As for dep. claims 33-35, basically this system claim have the same limitation as the dep. claims 25-27 above, they are rejected for the same reason sets forth the dep. claims 25-27 above.

As for claims 36-37, which deals with the pending delivery comprises a plurality of pending delivery items each corresponding to a return authorization item, this is fairly taught in HAUSER ET AL, figures 1-3. Note , "the record/information or data of a the delivery items" have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01.

As for claim 38, which deals with the first database is configured to split the first record, this is fairly taught in HAUSER ET AL {see 1-3, 5-6B}.

As for claim 39, which deals the second database is configured to split the second record this is fairly taught in HAUSER ET AL {see 1-3, 5-6B}.

As for independent claim 40, HAUSER ET AL discloses a system for managing a product return comprising:

a computer configured to assign a return authorization number (RAN) to a product return

{see figures 1-2 5-6B; col. 4, lines 2-23, col. 8, lines 10-45, merchant website and return authorization engine for generating the authorization number/authorization bar code

a plurality of databases, each configured to receive the RAN and to create at least one record corresponding to the product return, wherein each record corresponding to the return item is uniquely associated with the RAN

{see figures 1-2, 5-6B disclose the merchant website/ and central return facility databases.

{see at least figures1, 5-6B, col. 2, lines 9-25, lines 49-59; col. 5, lines 5-19 col. 8, lines 29-54 disclose the transmitting of the RA data (218) about the product return from the merchant system (return authorization engine) to the national return center system. This indicates that the unique identifier is stored in both systems (merchant and central return facility). The facility issues the return label including the bar code/unique identifier to customer, when the merchandise/product is returned at the facility, the bar code will be scanned to identify the merchant and merchandise being returned. If the return product that was received/returned match the expected merchandise, an electronic transmission/message is sent to merchant 14 indicating a complete return of the merchandise occurred}.

Note as indicated above, the first database and a first computer in the second step is inherently included in the figure 5-6B “merchant website and return authorization

engine" network system. Alternatively, the insertion of the term "a first database" in the merchant system above would have been obvious to provide the database or server in the merchant site in order to create and store the data/information/record about the product return e.g. the return authorization code so that the merchant can be able to keep track the status of which merchandised has been returned.

As for independent claim 41, HAUSER ET AL discloses a system for managing a product return, the system comprising:

a first computer comprising a user interface for receiving a return request from a customer

{see figures 1-2, figures 5-6B, col. 1-23, col. 8, lines 11-54}}

second computer, in communication with the first computer, configured to receive the RAN, and to create, upon receipt of the return authorization, a record in a database comprising the RAN

{see figures 1-2, col. 4, lines 1-23, col. 6, lines 18-49}

Note: that it appears that independent claim 41 is an apparatus claim. In examination of the apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114. *In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997*). Apparatus claims cover what a device is, not what a device does. Hewlett-Packard Co. vs. Bausch & Lomb Inc. (Fed. Circ. 1990). Manner of operating the device or elements of the device, i.e.

recitation with respect to the manner in which a claimed apparatus is intended to be employed/used, does not differentiate apparatus from the prior art apparatus. *Ex parte Masham*, 2 USPQ2d 1647 (BPAI, 1987).

Also, this is an apparatus claim and intended use limitation for the system/device or apparatus, i.e. "for receiving a return request…the RAN" carries no patentable weight.

As for claims 42-44, which deals with the communication between the customer and manufacture for the product return using the website for transmitting the label. This is taught in HAUSER ET AL, see figures 1-2, 5-6B

As for claim 45-47, which deals with the method of communication using the EDI, (electronic data interchange), Basic Application Interface (BAPI) and R/3 information object. This is inherently included HAUSER ET AL{figures 1-3, 5-6B}, wherein the first and second computers communicate using an EDI. Moreover, using these parameters for communicating between two systems are common, old and well known in the art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
3/23/09